REMARKS

This amendment is submitted in response to the Examiner's Final Action dated August 10, 2005 and pursuant to a telephonic conference between Examiner and Applicants' representative on October 10, 2005. During the telephonic conference, Examiner indicated her willingness to enter the present amendments, which removes the particular limitation of the claims subjected to the § 112 rejections. The amendments to the claims also comply with the Examiner's reading of the rejected claims, as noted at the bottom of page 3 of the Action. No new matter has been added, and the amendment places the claims in better condition for allowance and/or appeal. Applicants respectfully request entry of the amendments to the claims. The discussion/arguments provided below reference the claims in their amended form.

CLAIMS REJECTIONS UNDER 35 U.S.C. § 112

At paragraph 2 of the Office Action, Claims 1, 6 and 11 are rejected under 35 U.S.C. § 112, first paragraph. Specifically, those claims are rejected for reciting "a predetermined level of data processing," which Examiner states is not described in the specification... At paragraph 4 of the present Office Action, Claims 1-2, 4-7, 9-12 and 14-15 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. This latter rejection is however also predicated on the presence within the claims of the "predetermined level" language.

As noted above, Applicants have amended the claims to remove this feature of the claims. The claims now recite the language suggested by Examiner at the bottom of page 3 of the Action. The amendment removes the rejected feature and thus overcomes the § 112 rejection. Applicants respectfully request reconsideration and removal of the rejection in light of the amendment.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

At paragraph 6 of the present Office Action, Claims 1-2, 4-7, 9-12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Alam, et al.* (U.S. Patent No. 6,336,124) in view of *Hohensee, et al.* (U.S. Patent No. 5,813,020), *Vanderwiele, et al.* (U.S. Patent No. 5,767,833) and *Orton, et al.* (U.S. Patent No. 6,590,674). Assuming motivation can be found to support this combination of the various references, that combination does not render Applicant's

claimed invention obvious because that combination fails to suggest to one skilled in the art several key features recited by Applicants' claims.

At the onset, Applicants respectfully request Examiner consider the arguments provided herein, since these arguments are different from those previously provided, despite the similar grounds of rejections. Applicants hereby incorporate by reference those arguments proffered in the Appeal Brief and Amendment E. Several of those arguments are expanded upon herein, particularly those related to the independent claims. Sub-headings are provided to delineate and/or differentiate the particular arguments associated with the specific features identified.

Invention Summary

Applicants' invention provides a method, system and computer program product for minimizing processing requirements (e.g., processing time) while maximizing output quality for presentation data that is to be sent to a physical output device (such as a display, printer, fax) or a logical output device (such as an email generator or a data processing system). A data set is divided into objects and further divided into units so that each unit within an object contains a similar data type. Units that require less processing power for presentation are stored in a device-independent format. Units that require more processing power for presentation are stored in device-dependent format (as well as device independent format) determined by the presentation parameters of the presentation device attached to the computer system. During subsequent presentation of the data set to an output (presentation) device, the data image is assembled from the storage area as a combination of the units stored in the device-independent format and other units stored in device-dependent format, based on the specific presentation device being utilized.

References & General Arguments

Examiner relies on the above mentioned combination of references, which Applicants' maintain does not teach or suggest several key features recited by Applicants' claimed invention. Specifically, none of the references nor the combination of references suggest **"determining whether the unit is complex based on an amount of data processing required to convert** said unit to device-dependent format" (emphasis added). Also, none of the references nor combination thereof suggests "**storing said units, requiring more data processing** to convert to

said device-dependent format, **in said device-dependent format** based on the classified plurality of presentation devices" (emphasis added).

With respect to the first element above, Examiner has correctly analyzed that *Alam* is devoid of that teaching. However, Examiner relies on *Vandewiele* (specifically providing an analysis of *Vandewiele's* description within the abstract) to support the rejection of this key feature of Applicants' claims. What Examiner apparently fails to comprehend is that *Vandewiele's* system "determines the level of required resolution for supporting that image and then converts that image to the external bit map format at that desired level of resolution... selectable from either 24 bits per PEL (bpp), 8bpp, or 4 bpp." One skilled in the art appreciates the inherent distinction between (a) simply providing correct resolution for an image within a bit map and (b) actually evaluating when an image unit requires more data processing to convert to device dependent format for a particular presentation device and storing that image in device dependent format. Clearly, nothing within the above recitation from *Vandewiele* discusses or suggests determining whether the bit is complex and when it is storing it in device-dependent format.

Having read the other references as well, Applicants find no teaching or suggestion within the references for the above-recited features of Applicant's claimed invention. While Examiner has concluded that these features would be obvious, the references fails to support that conclusion and Examiner provides no further support that justifies such a conclusion.

Legal Analysis

In rejecting claims under 35 U.S.C. §103, it is incumbent upon Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. i, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior, art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc.

v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed- Cir. 1985,); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Further, it is established that "[d]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ADT Corp. v. Lydall, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

Improper Hindsight Utilized to Combine References and Reject the Claims

Applicants incorporate the argument related to improper hindsight reasoning presented in the Appeal Brief, and Applicants reiterate that Examiner presents as "evidence" a bare assertion that the logical process of determining whether to store units in dependent or independent formats is obvious without citing even a single reference that performs or suggests making such a complexity determination before storing the units (in multiple formats). Applicants again submit that the Examiner has not set forth evidence sufficient to support a prima facie case of obviousness. The Examiner's evidence of obviousness is created from broad conclusory statements about the knowledge of those with ordinary skill in the art without any objective evidence of a suggestion for performing the complexity determination and then storing the units accordingly, as performed in Applicants' independent claims. However it is established that "[d]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ADT Corp. v. Lydall, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

Specific Claim Elements:

A. The Step of "Determining" is Not Shown or Suggested

With respect to each independent claim (e.g., claim 1), therein is recited the step of:

> *for each unit, determining whether the unit is complex based on an amount of data processing required to convert said unit to device-dependent format*

None of the references (neither *Orton, Vanderwiele, Alam,* nor *Hohensee*) individually, nor in combination with each other, show or suggest the "determining" element recited within

each independent claim. Examiner has not specifically provided any arguments supporting the rejection of this element of Applicants' claims. That is, no specific arguments are provided addressing the present "determining" step provided within the claims.

Vanderwiele's description at col. 5, line 19 – col. 6, line 12 does not provide any suggestion of an actual determination of the complexity of the unit based on the amount of data processing required to convert the unit to device-dependent format. As explained in cols. 5 and 6 and as seen at steps 304, 306, 310, 320, 308 and 330 (of Fig. 3), the only comparison or determination made in *Vanderwiele*'s methodology as described in Fig. 3 is of the device and image type. Most importantly, *Vanderwiele*'s methodology performs the conversion from device independent bits to device dependent bits is performed in every single case (see end blocks 314, 328 and 338), and NOT in selected cases in response to a prior complexity determination. The only determination made by *Vanderwiele*'s system is what resolution or device-dependent format the image should be converted to. *Vanderwiele* therefore does not show or suggest this feature of the present invention.

B. The Step of "Storing" is Not Shown nor Suggested

Applicants' independent claims further recite:

> *storing said units, requiring less data processing to convert to device-dependent format, in device-independent format;*
>
> *storing said units, requiring more data processing to convert to device-dependent format, in device-dependent format based on the classified plurality of presentation devices;*

Again, all arguments proffered in the Appeal Brief addressing these elements are hereby incorporated by general reference thereto. Applicants reiterate that none of the cited art suggests either of the above steps since none of the prior art even contemplates conditioning such a conversion of an image or the storage thereof on a complexity determination based on the amount of data processing required to convert the individual unit to device-dependent format.

Given the above reasons, it is clear that the combination of references does not suggest key features of Applicants' invention, and one skilled in the art would not find Applicants' invention unpatentable over the combination(s). The above claims are therefore allowable over the combination(s).

CONCLUSION

Applicants have diligently responded to the Office Action by amending the claims to more accurately recite the features of the invention and overcome the § 112 rejections. Applicants further provide arguments that conclusively rebut the 103(a) rejections of the claims. Since the amendments and arguments overcome the §112 and §103 rejections, Applicants respectfully requests reconsideration of the rejections and issuance of a Notice of Allowance for all claims now pending.

Applicants further respectfully request the Examiner contact the undersigned attorney of record at 512.343.6116 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,

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